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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10-002,961	10.26.2001	Michael A. Lynes	883933.0070	4452

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CUMMINGS AND LOCKWOOD  
GRANITE SQUARE  
700 STATE STREET  
P O BOX 1960  
NEW HAVEN, CT 06509-1960

EXAMINER

WINSTON, RANDALL O

ART UNIT PAPER NUMBER

1654


DATE MAILED: 12.17.2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No. <b>10/002,961</b>	Applicant(s) <b>Lynes et al.</b>
Examiner <b>Randall Winston</b>	Art Unit <b>1654</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on \_\_\_\_\_.
- 2a)  This action is FINAL.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) \_\_\_\_\_ is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims 1-20 are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some\* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |  |
|--|--|
| 1) Notice of References Cited (PTO-892)                        | 4) Interview Summary (PTO-413) Paper No(s).        |
| 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)    | 5) Notice of Informal Patent Application (PTO-152) |
| 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). | 6) Other:  |

Art Unit: 1654

## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, drawn to a system for monitoring the effect of extracellular chemical stimuli on the translational motion of cells, classified in class 435, subclass 29, for example.
  - II. Claims 8-16, drawn to a method of monitoring the translation motion of cells in response to extracellular chemical stimuli, classified in class 435, subclass 4, for example.
  - III. Claim 17-18, drawn to a method for determining the impact of a test substance on the ability of a chemical agent to affect the translational movement of cells, classified in class 435, subclass 4, for example.
  - IV. Claims 19-20, drawn to a system for the non-optical imaging of translational cell movement, classified in class 435, subclass 283.1, for example.
2. The inventive groups above are directed to different inventions which are not connected in design, operation, and/or effect. These methods (Inventions II-III, methods, are distinguishable, each from the other, by each of applicants' methods has a different mode of operation (i.e. applicant Inventions II and III are different because Invention II, is drawn to a method of monitoring the translation motion of cells in response to extracellular chemical stimuli whereas Invention III is drawn to a method of determining the impact of a test substance on the ability of a chemical agent to affect the translational movement of cells) and compositions (Inventions I and IV are distinguishable, each from the other, by Invention I composition is

Art Unit: 1654

drawn to a system for monitoring the effect of extracellular chemical stimuli on the translational motion of cells whereas Invention IV composition is drawn to system for the non-optical imaging of translational cell movement) are distinct since they are not disclosed as capable of use together, they have different modes of operation, they have different functions, and/or they have different effects. In addition, one would not have to practice the various methods and/or use the various compositions at the same time to practice just one method alone and/or one composition alone.

3. The several inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches (as indicated by the different classification). The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. Finally, the consideration for patentability is different in each case. Thus, it would be an undue burden to examine all the above inventions in one application.

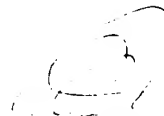
Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirements be traversed (37 CFR 1.143).

Art Unit: 1654

Any inquiry concerning this communication should be directed to Randall Winston at telephone number (703) 305-0404. The examiner can normally be reached during the hours of 08:30 to 17:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful. A message may be left on the voice mail. The fax number the Art 1654 is (703) 308-4242 or 305-3014. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196. My supervisor, Brenda Brumback, may be contacted at (703) 306-3220.

Randall O. Winston  
Examiner, 1651

  
RECEIVED  
REMANENT EXAMINER